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OFFICE OF PETITIONS

In re Application of	:	
Gilles, et al.	:	
Application No. 10/540,306	:	DECISION
Filed: 20 June, 2005	:	
Attorney Docket No. 084329-000000US	:	

This is a decision on the petition filed on 6 September, 2006, under 37 C.F.R. §1.182.

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.

The petition as considered under 37 C.F.R. §1.182 is **GRANTED in part** and **DISMISSED in part**.

NOTES: Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.182."

BACKGROUND

The record reflects that:

- the instant application was filed on 20 June, 2005, and thereafter proceeded through initial application examination for formalities;

- based upon the application data sheet (ADS) and the oath/declaration submitted by Petitioner on filing, the Office set out the names and order of inventors (of the inventive entity) as : Ronald Mark Gilles Peter Walsh, Jim Iliopoulos, Alberto Pompeo Avolio, William Walsh and Michael O'Rourke;
- in the petition filed on 6 September, 2006, Petitioner avers that:
 - (a) the foregoing listing on submission in fact "was in no particular order," however, the order now needs to be corrected; and
 - (b) the identification of Ronald Mark Gilles was erroneous: while the inventor so signed the oath as "Ronald Mark Gilles" without change or alternation, his name in fact is "Mark Ronald Gilles," and this, too, must be corrected.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)), and that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.¹

ANALYSIS

Petitioner has sought relief under the provisions of 37 C.F.R. §1.182.

As to the Correction of the Order of Inventors

The commentary set forth at MPEP §605.04(f) indicates that

¹ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

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[T]he particular order in which the names appear is of no consequence insofar as the legal rights of the joint applicants are concerned, no changes will be made except when a petition under 37 C.F.R. §1.182 is granted. The petition should be directed to the attention of the Office of Petitions. The petition to change the order of names must be signed by either the attorney or agent of record or all the applicants. Applicants are strongly encouraged to submit an application data sheet showing the new order of inventor names to ensure appropriate printing of the inventor names in any patent to issue.”

This Petitioner has done.

As to the Correction
of the Inventor's Name

The commentary set forth at MPEP §605.04(c) clearly indicates that a declaration attesting to the facts surrounding the error and to the truth of the correction is to be signed by the declarant under both the former name/alias/nickname and the proper legal name. (Emphasis supplied.)

This Petitioner has failed to do.

CONCLUSION

Thus, Petitioner appears to have satisfied his burdens herein only in part.

Accordingly, the petition as considered under 37 C.F.R. §1.182 to:

- set forth the order of inventors (as O'Rourke, (William) Walsh, Iliopoulos, Avolio, Gillies, and (Peter) Walsh) is **granted**; however,
- the petition to alter/correct the name first and second names of inventor Gilles is **dismissed**, pending determination following Petitioner's submission of the statement/declaration by inventor Gillies and signed by him under both names (i.e., Ronald Mark Gillies and Mark Ronald Gillies) as discussed above.

Upon resubmission, Petitioner should reassert his request for relief as to both matters in order that the Office of Initial Patent Examination might address both matters at one time.

Further correspondence with respect to this matter should be addressed as follows:

Application No. 10/540,306

By mail: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
(571) 273-8300
ATTN.: Office of Petitions

By hand: Mail Stop: Petition
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2²) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

² The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.